

REMARKS

The Applicant hereby submits the present ***Corrected*** Amendment and Request For Reconsideration for the above-referenced patent application in response to the Notice of Non-Compliant Amendment mailed on 12 January 2006, which is responsive to the Office Action mailed on 23 December 2005, entry of which is earnestly requested.

In the present Amendment, the Applicant amends 1, 3, 5, 14, 17, 18, 19, 20, and 21; no claims have been canceled. Claim 14 has been amended to include limitations of previous dependent claim 19, but otherwise has not been substantively altered. Therefore, claims 1-25 as amended remain pending in the present application. The Applicants respectfully submit that no new matter has been entered by such amendments. The amendments are supported fully in the application as originally filed.

In the Office Action mailed on 23 September 2005, the Examiner objected to the Abstract due to its length. In response, the Applicants amend the Abstract according to the Examiner's suggestion on page 3 of the Office Action.

In the same Office Action, the Examiner objected to claims 1 and 20 due to perceived antecedent basis issues. To satisfy any perceived ambiguity of the Examiner, the Applicants amend claims 1, 14, and 20 according to the Examiner's suggestions on page 5 of the Office Action. The Applicants note, however, that the terms "memory" and "control circuitry" are not normally used with the article "a" preceding such terms; therefore, such amendment should not be accorded any weight for claim interpretation purposes.

In the same Office Action, the Examiner objected to claim 21 since it should use the phrase "selected from the group consisting of." In response, the Applicants amend claim 21 in accordance with the Examiner's suggestion on page 5 of the Office Action.

In the same Office Action, the Examiner objected to some of the Drawings since some of the reference characters have been utilized twice to reference different components in the drawings. The Applicants submit, however, that the informalities identified by the Examiner are actually informalities in the specification and not in the drawings themselves. Therefore, the Applicants amend the specification by providing replacement paragraphs in the specification to correct the reference character informalities. No new matter has been entered. The Applicants respectfully submit that such informalities are now corrected and the objections may now be withdrawn.

In the same Office Action, the Examiner objected to the Title as not being descriptive. In response, the Applicants respectfully disagree. The Applicants' present title is indeed descriptive of the preferred apparatus which is described in the patent application: a "year-round" type decorative lighting apparatus which has "selectable holiday color schemes". The claims of the present application also relate to an apparatus and techniques suitably described in the title. Further, the Applicants submit that the Examiner's suggestion is less descriptive than that of Applicants'. Therefore, the Applicants respectfully request the Examiner to withdraw such objection.

In the same Office Action, the Examiner rejected claims 1-25 as being unpatentable under 35 U.S.C. § 103(a) over KRAMER (U.S. Patent No. 3,789,211), KAZAR (U.S. Patent No. 5,008,595), and LOWE et al. (U.S. Patent No. 6,424,096). In response, the Applicants respectfully submit that the claims 1-25 as amended are allowable over the prior art of record for at least the following reasons.

To establish a prima facie case of obvious under 35 U.S.C. § 103(a), the prior art references in combination must teach or suggest each and every limitation of the claims. In addition, there must be an adequate suggestion or motivation to combine the teachings of the combined references.

KRAMER And KAZAR Fail To Teach Or Suggest The Use Of Addressable Color-Controllable RGB LED Nodes In A Year-Round Type Apparatus And Method As Claimed. In the present case, KRAMER and KAZAR fail to teach or suggest “addressable color-controllable RGB LED nodes” as recited in the claims. A node that is “addressable” is indeed understood by those ordinarily skilled in the art as one that is accessible via a computer address, as in computer addressable memory. In contrast, KRAMER merely teaches AC lines which provide electrically power each colored incandescent lamp. No computer-type addressing is used and no data is sent to control the color of the lamps of KRAMER. KAZAR also fail to teach or suggest such nodes and limitations.

The Applicants submit two examples of definitions of such term from dictionary sources (see Attachments 1 and 2) (“capable of being addressed; ‘addressable memory’” and “accessible through an address, as in computer memory”). In addition, the present application defines these terms pertaining to the present inventive apparatus and methods. In the present application on page 7 at lines 13-17, for example, it is described that “each color-controllable RGB LED along the plurality of wires 106 is embodied at a node which is addressable and may be illuminated with an appropriate color by sending appropriate color data over data lines to an address associated with the node. The color mixing techniques are utilized locally at each node with its corresponding RGB LED to provide for a variety of colors other than red, green, and blue (e.g. orange, yellow, white, etc.). In FIGS. 1-2, each LED node is identified with a particular address represented by L1, L2, L3, L4, etc.”

Claim limitations of the present application further recite steps such as “sending the color data over one or more data lines to addressable color-controllable RGB LED nodes associated with LED node address data” which are further descriptive of these types of nodes, not taught or suggested by KRAMER and KAZAR.

The Applicants further submit that neither KRAMER or KAZAR even teach or suggest the use of “RGB LEDs” in any way to enable one ordinarily skilled in the art to make or use any such apparatus. The passage in KAZAR to which the Examiner makes

reference is merely a speculative passing statement regarding an unrealized possibility, without technical support or enablement to make and use any such apparatus with such devices. KAZAR describes an implementation which makes use of bicolored LEDs, whereas KRAMER describes an implementation using standard incandescent lamps.

As apparent, it is clear to one ordinarily skilled in the art that neither KRAMER nor KAZAR teach or suggest the recited limitations of “addressable color-controllable RGB LED nodes”. Any broader interpretation of the term “addressable color-controllable RGB LED nodes” in the claims would not be a reasonable interpretation, in light of this term’s plain and ordinary meaning and definition in the patent application. For these reasons alone, the Applicants respectfully request the Examiner to withdraw the §103(a) rejections and to allow claims 1-25 as amended.

There Is No Adequate Suggestion Or Motivation Provided To Combine The Teachings To Demonstrate Any Obviousness. The Applicants also respectfully submit that there is no adequate suggestion or motivation to combine the teachings of the prior art. For example, KRAMER teaches away from the modifications suggested by the Examiner. In particular, KRAMER cannot be modified as suggested to teach that which is claimed, as the modification is against the primary intent of KRAMER.

The primary intent of KRAMER is to produce a decorative lighting system with *special lighting effects*: dynamically changing colored lights. The circuits of KRAMER are specifically configured to provide such dynamically changing colors over time for a special effect. Special lighting effects specifically addressed in KRAMER have been an important part of the excitement and sales of *Christmas* lights. The lights of KRAMER are controlled by the control means in “an independent and random fashion between on and off” (see KRAMER 1:38-40) or alternatively to display “a gradual dynamically changing mono-color light.” If the teachings of KRAMER were modified as the Examiner suggests, the goal of KRAMER would be defeated.

For these reasons alone, the Applicants respectfully request the Examiner to withdraw the §103(a) rejections and to allow claims 1-25 as amended.

The Claim Invention Is Patentable For Reasons Which Include Providing Multiple Holiday Color Schemes For Year-Round Type Lighting Usage. The Examiner further argues that the claimed holiday color scheme limitations relate to ornamentation only with no mechanical function, which cannot be relied upon to patentably distinguish from the prior art, and cites In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

In response, the Applicants respectfully disagree with the Examiner's argument. For one, the courts have subsequently rejected such overgeneralized rejections and determinations, as in Ex parte Hilton, 148 USPQ 356 (Bd. App. 1965) and In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). In addition, the claims do not merely recite some vague form of "ornamentation" – but rather concrete elements and functionality for achieving a desired advantage: a decorative lighting apparatus having year-round use and functionality. For example, the claims recite "memory for storing data for a plurality of holiday color schemes, each holiday color scheme associated with one or more different holiday colors"; and "sending the holiday color data over one or more data lines to addressable color-controllable RGB LED nodes associated with LED node address data" for each user-selectable switch setting. Finally, the Applicants identify evidence that the resulting apparatus provides an advantage from the public's perspective, in the form of the newspaper article "Lights Go Up, Never Come Down" from the Chicago Sun-Times, submitted in an earlier IDS by the Applicants. This newspaper article was written in response to the publication of the parent application to which this application claims priority, without initiation by the Applicants. The public response was enthusiastic. As apparent, the claimed limitations regarding holiday color schemes touch upon more than just mere ornamentation without further functionality or utility.

As a side note, the Applicants submit that KAZAR also fails to sufficiently teach "a decorating selector which provides a plurality of user-selectable switch settings" in order "to illuminate addressable color-controllable RGB LED nodes along the decorative light strand with a different holiday color scheme for each user-selectable switch setting."

In fact, the specification and drawings of KAZAR reveal no selector or switch, or any mechanism to process such selector or switch to cooperate with the circuitry of KAZAR; no enablement for such limitations exist. On the other hand, KAZAR does mention in passing in column 3 at lines 6-12 that a user may be allowed “to select individual lights to be constantly illuminated or flash in response to an oscillating voltage source.” However, this passage for selecting lights to be either constantly illuminated or flashing may be a conventional technique which is not the specific focus of the present application. KAZAR further mentions in passing that it may “allow multicolor patterns to be generated”. However, techniques to achieve eye-catching time-sequenced multicolor lighting effects (time-sequenced chase lights, wave patterns, etc.) is also not the specific objective of the present application. Rather, the focus of the present application relates to providing specific holiday color schemes with specific color combinations useful to end users for different holidays or occasions throughout the year using addressable color-controllable RGB LED nodes.

As apparent, KRAMER and KAZAR together fail to adequately teach or suggest multiple holiday color schemes for a year-round decorative lighting apparatus using a decorating selector such as a keypad for year-round use.

There Are Additional Claim Limitations Not Taught Or Suggested, And No Inherency Has Been Adequately Articulated. The Applicants respectfully submit that other limitations are not taught in the references. For example, “memory” and “data stored in the memory” are not taught or suggested in KRAMER or KAZAR. If inherency is being argued, then the Examiner has failed to adequately articulate such inherency for these elements as required by the rules. As another example, KRAMER and KAZAR fail to teach or suggest the limitation that “each user-selectable color-control switch being associated with a corresponding one of the plurality of colors” (claim 14 as amended, previous dependent claim 19). Again, if inherency is being argued, then the Examiner has failed to adequately articulate such inherency for these elements as required by the rules.

Other Reasons For Allowability. One ordinarily skilled in the art appreciates that further reasons for allowability of the claims is apparent, but these reasons are deemed moot in light of all of the reasons described above and are therefore not specifically addressed in this paper.

The Applicants respectfully requests entry of the present Amendment and reconsideration of claims 1-25 as amended. In light of the amendments and the above-stated reasons, the Applicants respectfully request the Examiner to withdraw the pending objections and rejections. The Applicant respectfully submits that the application as amended is now in a condition suitable for allowance.

Thank you for your reconsideration of the application as amended. The Examiner is invited to contact the undersigned to expedite prosecution of the present application in any way.

Date:

11 Jan 2006

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Respectfully Submitted,

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Attachment 1

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addressable

A adjective

1

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capable of being addressed; "addressable memory"

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